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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,977	07/28/2003	Andrzej Wozniak	T2147-908626	4096

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

SILVER, DAVID

ART UNIT PAPER NUMBER

2128

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/627,977	Applicant(s) WOZNIAK, ANDRZEJ	
	Examiner David Silver	Art Unit 2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 36-82 are pending in Instant Application.

Priority

2. Examiner acknowledges Applicant's claim to priority benefits of 02 09690 07/30/2002 FRANCE.

Information Disclosure Statement

3. The information disclosure statement(s) (IDS) submitted on 12/15/03 is/are in compliance with the provisions of 37 CFR 1.97. The IDS has only been considered with respect to its qualification as a prior-art document based on publication dates. The IDS was **not** considered with respect to the merits of the case and the claimed invention because of numerous 35 USC § 112 deficiencies recited below and in view of **MPEP 2173.06** and *In re Steele*.

Drawings

4. Figures 1, 3A-C, and 5 should be designated as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a **single paragraph** on a separate sheet **within the range of 50 to 150 words**. It is important that the **abstract not exceed 150 words** in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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5. The abstract of the disclosure is objected to because it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

Appropriate correction is required.

Claim Objections

6. Claims 36-82 are objected because they do not follow standard US claim construction. An example of such a situation is claim 58. Specifically, it is unclear as to where the preamble ends and the body of the claim begins.
7. Furthermore, claims 52 merely recite a preamble without limitations. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 58-71 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
- 8.1 In this instance, absent an explicit and deliberate definition in the specification that the product includes an appropriate medium or hardware elements, the claims are directed to software *per se*. Note exemplary claim 58 which recites only software elements. Additionally, software, *per se*, is not considered concrete under the above-recited MPEP citation (MPEP 2106).
- 8.2 The above rejection is merely exemplary.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 36-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

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enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claims 36-57, the following questions are merely exemplary of the plethora of 112 enablement deficiencies: what is a "Configurator"? What does the phrase "can constitute" mean? How is the "help of an automatic Configurator" performed? What is "a part of a machine?" What is an "environment simulation"? How are things "made possible"? What are "fixed functional blocks"? What is a connection rule table? How is "information related to all of the possible configurations" established? How are the unambiguously identifier established? What are invoking procedures? In the preamble, what comprises the items listed following line 14, the method, the data processing system, the description file, the components, the Configurator, the automatic Configurator? What are the differences between the Configurator, the automatic Configurator?

As per claims 58-71, the following questions are merely exemplary of the plethora of 112 enablement deficiencies: what is a global simulation model? What are fixed functional blocks? What are the items being mutually connected (data processing system, global simulation model, fixed functional blocks)? What is comprising models of integrated circuits under development? How is conformity established? How is a regular expression able to create a simulation?

As per claims 72-82, the following questions are merely exemplary of the plethora of 112 enablement deficiencies: how are "all of the possible configurations" established? What is an instance connection table? How are the topological connections made? How are the signals physically connected? How are the HDL and HLL-type source files automatically generated?

10. Claims 36-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the **written**

description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per claims 36-82, the instant claims are rejected for failing to comply with the written description

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requirement because the subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, note the 35 USC § 112 enablement rejections applied above. The instant claims are rejected for failing to comply with the written description requirement for at least the items enumerated above. The deficiencies above are merely exemplary.

11. Claims 36-82 are rejected under 35 U.S.C. 112, second paragraph, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

12.1 Claim 36 fails to set the metes and bounds for at least the following exemplary reasons:

Line 8 has an ambiguity, what is "the components" referring to?

Line 18 what are "several types"? The term "such as" fails to set the metes and bounds of the claimed invention.

Line 22 what are "the present components"?

Regarding claim 36, the phrase "such as" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

12.2 Claim 58 fails to set the metes and bounds for at least the following exemplary reasons:

Which phrase is the transitional phrase that separates the preamble from the claim body.

12.3 Claim 72 lacks antecedent basis for "the corresponding information"; "the interface signals", "the possible configurations", "the components"

13. The above cited rejections are merely exemplary.

14. The Applicant(s) are requested to correct all similar errors.

15. Claims not specifically mentioned are rejected by virtue of their dependency.

Claim Rejection - Claims not searched or treated on merits with respect to prior-art

MPEP 2173.06 Prior Art Rejection of Claim Rejected as Indefinite recites:

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As stated in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 U.S.C. 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims.

16. Claims 36-82 have not been treated on merits because the claims are replete with claim formulation and 35 USC 112 errors. As such, it is difficult to ascertain the metes and bounds of the invention the Applicants regards as their own. Therefore, claims 36-82 have not been treated on merits.

The above-cited 35 USC 101 rejections, 35 USC 112 rejections, claim objections and specification objections are merely exemplary. The Applicants are required to fix all other occurrences of similar deficiencies.

Examiner Requests

17. The Examiner respectfully requests, in the event the Applicants choose to amend or add new claims, that such **claims and their limitations be directly mapped to the specification, which provides support for the subject matter**. This will assist in expediting compact prosecution.

Conclusion

18. All claims are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Silver whose telephone number is (571) 272-8634. The examiner can normally be reached on Monday thru Friday, 10am to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached on 571-272-2279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at

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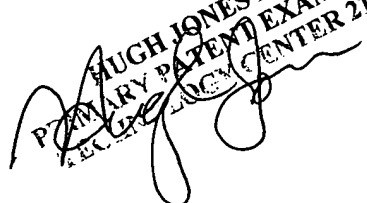
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866-217-9197 (toll-free).

David Silver
Patent Examiner
Art Unit 2128

9/2/06


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100